REMARKS

Initially, Applicant expresses appreciation to the Examiner for the courtesies extended in the recent telephonic discussion of this case. The remarks presented herein are consistent with those discussed. Accordingly, entry of this amendment and reconsideration of the pending claims is respectfully requested.

The Office Action mailed December 23, 2008, considered and rejected claims 1, 2, 5, 7, 8, 22-25 and 32-34. In particular, claims 1, 2, 5, 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward* (U.S. Patent No. 6,756,997), in view of *Marsh* (U.S. Patent No. 6,208,799), *Bertis* (U.S. Patent No. 6,564,005), *Horlander* (U.S. Patent No. 6,650,824), and *Sankaranarayan* (U.S. Patent No. 7,111,927). Claims 22-25 and 32-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward* and *Marsh* in view of *Alexander* (U.S. Patent No. 6,177,931).[1] Additionally, claims 32 and 33 were objected to for an informality which has been corrected by this paper.[2]

By this paper, claims 22 and 32-34 have been amended, while no claims have been cancelled or added. Accordingly, following entry of this paper, claims 1, 2, 5, 7, 8, 22-25 and 32-34 remain pending, of which claims 1, 22 and 34 are the only independent claims at issue.

As reflected above, Applicant's claims are generally directed to managing conflicting recording schedules for broadcast recordings. In particular, the claims recite an invention that allows a conflict in a broadcast schedule that exists at the time the user selects recording to be immediately stored and to persist such that the conflict can be automatically resolved, <u>without a user or system immediately attempting to resolve the conflict or re-program the scheduled recordings</u>. As reflected in claim 1, for example, an exemplary method according to the present invention includes receiving user input from a particular user selecting a first program to be recorded. Thereafter, the same user selects a second program for recording. At the time the user input selecting the second program for recording is received, it is determined that a conflict exists between the first and second programs. Despite the conflict, the system abstains from attempting to resolve the conflict, and instead stores the conflicting information in a recording

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[1] Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

[2] As discussed with the Examiner, although the Office Action states that the objection was to the Specification, inasmuch as the objection was based entirely on the dependency of the claims, the objection was to the claims rather than the specification.

list indicating that the particular user has selected both the first and second programs for recording. The stored information thus persists a conflict that existed at the time the second program was selected. The system then selects the first program and programs the recording apparatus to schedule recording of the first program at the first broadcast time. Subsequent to such programming, the recording apparatus continues to store the information specifying that the user has selected conflicting programs, without requiring a user to resolve the conflict. In response to a subsequent event such as detecting that a new tuner has been added or that a start/stop time of the first program has changed, the recording apparatus is automatically programmed to schedule recording of the second program at the broadcast time originally indicated.

Independent claim 22 recites a recording system and generally corresponds to the method of claim 1, except that it recites a recording list that displays all, and only all, programs selected for recording, and further is accessible by the user to visually indicate differences between each three circumstances, namely: (i) programs with a conflict but scheduled to record; (ii) programs with a conflict not scheduled to record; and (iii) programs without a conflict. Claim 34 recites elements of both claims 1 and 22, and further recites aspects related to a default rule set employed in selecting which program to record, and the reprogramming of the second program when a new tuner is detected.

Initially, with respect to the rejections of claims 1, 2, 5, 7 and 8, Applicant notes that the Office has failed to present a *prima facie* case of obviousness inasmuch as the Office has relied on a reference which does not qualify as prior art under 35 U.S.C. § 103(c). In particular, to the extent the *Sankaranayan* reference qualifies as prior art, it does so only under 35 U.S.C. § 102(e). Furthermore, the subject matter of the *Sankaranayan* reference and the claimed invention were, at the time the claimed invention was made, owned by the same entity (namely Microsoft), or subject to an obligation of assignment to the same entity. In particular, the present application was assigned to WebTV Networks which was at that time a wholly owned subsidiary of Microsoft. Although additional evidence is not required to disqualify art under 35 U.S.C. § 103(c), Applicant further notes that the relevant assignment documents are found in the Patent Office. For example, assignment documents for *Sankaranayan* were executed April 27, 2000, and were recorded on May 2, 2000 at Reel/Frame 010781/0929. Assignment documents for the

present application were formally executed as of March 20, 2001, and were recorded on April 3, 2001 at Reel/Frame 011671/0517.

With regard to the rejections of claims 22-25 and 32-34, Applicant notes that while *Ward, Marsh, Berstis, Horlander*, and *Alexander* are generally directed to recording programming, Applicant respectfully submits that they fail, whether cited individually or in combination, to disclose or reasonably support Applicant's invention as claimed above. For example, among other things, the cited references fail to teach or disclose a method or a system in a recording list that displays all programs selected by a user for recording, and only those programs selected for recording, visually distinguishes between three types of scenarios applicable to each of the programs, as recited in combination with the other claim elements. Indeed, the Office has expressly acknowledged that the very art cited for such a visual distinction provides such at least in part through an EPG (Office Action, p. 11, citing to Figure 1 of *Alexander*), which EPG includes a grid of programs according to time, and displays any programs available at that time, without regard to whether or not they are scheduled for programming.

In particular, *Alexander* describes an improved EPG that has, among other things, advertising and information sections displayed along with a grid guide and an action key bar. The action key bar includes buttons corresponding to keys on a remote control and display blue or green to indicate whether a user has selected to view or record a program. Thus, the EPG displays in its grid a list of all programs, regardless of whether or note they are scheduled for recording. Indeed, *Alexander* describes the EPG as an application that receives record instructions, not as an application that displays only programs which have been previously selected for recording

The record functionality of the EPG can also be set to recognize conflicts in the viewer's record instructions. Specifically, when a conflict is detected, "the EPG's Record Function prompts the viewer to resolve the conflict." (Col. 12, ll. 53-55). For example, the EPG could accept viewer instructions to record a particular program and compare those against unexecuted record instructions in a Record List. If the EPG detects an overlap in date, time or duration, the EPG formats a message to the viewer to describe the conflict. (Col. 12, ll. 56-64). That message then describes to the user the newly received instruction along with the particular program and the conflicting record instructions in the Record List. (Col. 12, ll. 64-66).

Notably, the EPG "prevents entry of conflicting instructions in the Record List." (Col. 12, ln. 67 to Col. 13, ln. 1). The EPG "will require" that the viewer revise the record instructions to eliminate the conflict. For example, the EPG can format an on screen message that notes that one instructions for a one occurrence program conflicts with a regularly recorded program, and allows the viewer to select which to record, or automatically decides to override the instructions for the regularly recorded program. (Col. 13, ll. 1-13). The conflict may also be resolved by choosing an alternative occurrence of the conflicting program. For example, the viewer can highlight a program in the EPG and request a list of all occurrences of that program, and then instruct the EPG to record an alternative occurrence. (Col. 13, ll. 14-23).

Thus, *Alexander* describes a system that: (i) prevents a Record List from having conflicting instructions; and (ii) automatically resolves the conflicts or sends on-screen messages to the user identifying only the conflicting information so that the user can resolve the conflict. Notably, both aspects are in direct contrast to the pending claims.

Specifically, the claims expressly recite that a recording list specifies information about programs selected to be recorded, despite the existence of a conflict, whereas *Alexander* expressly requires that conflicts be resolved before new program information can be input into the Record List. Furthermore, the pending claims recite that the Record List includes all programs to be recorded, and only programs scheduled to be recorded, while further visually distinguishing between programs selected for recording and that are subject to a conflict and still going to be recorded, subject to a conflict and not going to be recorded, and not subject to a conflict. In contrast, *Alexander* expressly notes that the Record List information does not include conflicting information as the conflicts are resolved before the information is put into the Record List. As there is no conflicting information in the Record List, the Record List itself cannot distinguish between conflicting programs that are and are not set to record; indeed no programs of either type are recorded in the Record List of *Alexander*. Moreover, the information cited by the Office as to distinguishing between each program relates to an on-screen message sent by the EPG, and which only identifies conflicting information. The on-screen message does not include all recorded programs, and the EPG generating the message includes all programs regardless of whether they are scheduled to be recorded. The Record List, which is the only list in *Alexander* that appears to include all programs selected to be recorded, and only those selected to be recorded, does not appear to be displayable to the viewer, and cannot distinguish between

conflicts as none are present in the recorded information. Further, the Office cites to the EPG itself for showing programs having no conflict.

Thus, one skilled in the art at the time of the invention, when considering the *Alexander* reference, could have only reasonably found support to prevent conflicts from occurring and being recorded to a Record List, and doing so by sending notifications to the viewer that a conflict is found and needs to be fixed. In contrast, the pending claims record information in the record list notwithstanding a conflict, and further visually distinguish between conflicting programs (both those that will and will not end up being recorded), as well as programs with no conflict.

Applicant respectfully submits that the other art of record is no more instructive in this regard. For instance, *Ward* discloses an EPG in which windows are provided to provide information to the user. (Col. 10, ll. 50-60). Using the EPG windows, a user can use a record function to select to record a future-scheduled program and have it recorded in the Record List. (Col. 11, ll. 48-60). Multiple record commands may be provided by the user and, in some cases, such commands can conflict by having overlapping dates, times and durations. (Col. 12, ll. 37-49). When the record function of the EPG receives viewer instructions to record a particular program, it compares the newly received instruction to other instructions in the Record List. (Col. 12, ll. 41-45). When the received second program is determined to have an overlap with the already listed program, the EPG generates a message that is presented to the user and which describes the conflict. (Col. 12, ll. 42-49). The user is then <u>required</u> to revise or discard the record instruction as the entry of conflicting instructions is prohibited in the Record List. (Col. 12, ll. 52-55). Thus, the second record command is stored in the Record List only after the conflict is resolved. *Ward* is thus directly complimentary to *Alexander* and teaches to not record information in the Record List unless a conflict is first resolved.

Marsh generally discloses a set-top VCR recording system which allows automatic adjustment of recording instructions upon the occurrence of changes to a program's recording schedule. In particular, a record request can be received for a particular program which has a particular date, time and duration. (Col. 7, ll. 18-20). When the request is received, and before it is stored in one of the systems record-timers, the request must be investigated for conflicts. (Col. 7, ll. 20-22). A conflict may exist because all of the record-timers have existing program record requests or because there is a day/time conflict. (Col. 7, ll. 24-39). In the case of a day/time

conflict, an alert is sent to the user's TV screen where the user cancels one of the conflicting requests. (Col. 7, ll. 38-44; Col. 13, ll. 35-54). It is only when no conflict exists that the record request is stored in the record timer. (Col. 7, ll. 44-48). As an alternative to cancellation, however, the same program can be set to record at a different time, date or channel. (Col. 13, ll. 54-60). Thus, *Marsh* discloses the use of a conflict resolution which, at the time of receiving the conflicting input, checks for an additional programming time for recording. Thus, as opposed to resolving the conflict after it has been stored in the recording/priority list and then recording it at the original time received and which was subject to the conflict, as is recited by the pending claims, *Marsh* is again fully consistent with *Alexander* and *Bertsis* and discloses the opposite— namely that the conflict is resolved up front by selecting to record a program at a different time.

Accordingly, when the references are cited in combination, the references actually disclose that conflicting events are initially removed or changed so that, upon later changes, there would be no record of the originally conflicting event so that it can be automatically restored, or merely that a conflict is presented to the user to make the user aware of the conflict. No disclosure or reasonable support, however, is found to indicate that when a conflict is found, it is recorded in the record list anyway (the record list being a list that is displayable to the user and includes all programs selected to be recorded, and only programs selected to be recorded). As there is no conflicting information in a record list, the art therefore necessarily also fails to disclose or reasonably support that the record list itself includes visual identifiers that distinguish between programs without conflicts, programs with conflicts and which will be recorded, and programs with conflicts but which will not be recorded.

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required reason why one skilled in the art would have modified the cited art in the manner officially noticed..

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (801) 533-9800.

Dated this 20th day of May, 2009.

Respectfully submitted,

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